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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,936	03/22/2001	Wayne Morgan John	713-409	1825

7590

05/21/2003

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

9

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

178

Office Action Summary

Application No.

09/813,936

Applicant(s)

JOHN ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-17,21,22,26,31 and 35-47 is/are pending in the application.
- 4a) Of the above claim(s) 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-17,21,22,26,31 and 35-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RESPONSE TO AMENDMENT

Election/Restrictions

1. Newly submitted claim 47 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the originally presented claims were directed to a panel which is an intermediate product of the final product claimed in claim 47 a stair tread.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 47 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

WITHDRAWN REJECTIONS

2. The objections to the Specification and the 35 U.S.C. §112 rejections of record in paper #7, pages 2-7, paragraphs #2-4 have been withdrawn due to Applicant's amendment in paper # 8.
3. The 35 U.S.C. §102 rejection of record in paper #7, page 7, paragraph #6 has been withdrawn due to Applicant's amendment in paper # 8.
4. The 35 U.S.C. §102/103 rejection of record in paper #7, pages 7-8, paragraph #7 has been withdrawn due to Applicant's amendment in paper # 8.
5. The 35 U.S.C. §103 rejections of record in paper #7, pages 8-11, paragraphs #9-10 has been withdrawn due to Applicant's amendment in paper # 8.

NEW REJECTIONS

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

7. Claims 6-17, 21, 22, 24, 26 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "inflexible" in claim 6 is a relative term, which renders the claim indefinite. The term "inflexible" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear to what degree the substrate must be inflexible. The examiner was not suggesting in the last office action that applicant use the term "inflexible," but was asking the degree of inflexibility.

Claim Rejections - 35 USC § 102

8. Claims 6, 7, 9-12 and 35-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Robbins, Jr. (4,340,633).

Robbins discloses a protective mat comprising a protective shield such as a sheet of paper (substrate), an adhesive layer, and a plastic material, which has projecting cleats (cut-resistant anti-slip coating) (col. 2, lines 49-65 and figure 3). The cleats that project from the surface of the plastic material will grip the carpet and hold the mat in a desired position (col. 2, lines 34-39).

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The mat can be made of a variety of plastic materials such as Lucite or vinyl and are presently manufactured in a variety of shapes to accommodate different layouts (col. 2, lines 20-26).

Robbins further discloses that for packaging the mats they can be attached and which is provided with severing lines on the plastic material in the form of perforations or score lines (uncoated cutting lines) to facilitate separation of the roll into individual segments (col. 3, lines 3-26).

9. Claims 6, 7, 8, 10-14, 22, 35-39, 43, 44 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Harper et al. (5,077,117).

Harper discloses a pavement marker comprising the pavement (inflexible substrate with working surface), a base layer, and a durable wear resistant layer (cut-resistant anti-slip coating) (figure 2). The durable, wear-resistant, polymeric top layer comprises a plurality of skid resistant aluminum oxide granules and have a plurality of ruptures (uncoated cutting lines/drilling areas) (figure 4 and col. 6, lines 63-65).

The phrase “in use, the substrate can be cut along selected uncoated cutting lines to obtain a desired panel shape” is an intended use. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. Other intended use phrases “in use, the substrate can be drilled at selected uncoated, drilling areas to obtain a desired placement of fixing holes”

Claim Rejections - 35 USC § 103

10. Claim 40 rejected under 35 U.S.C. 103(a) as being unpatentable over Harper et al. (5,077,117).

Harper discloses all the limitations of the instant invention except for the size of the particles. The exact size of the particles is deemed to be a cause effective variable with regard to the skid resistant property of the pavement marker. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such size of the particle through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to optimize the size of the particle in order to improve the skid resistant property.

11. Claims 15, 16, 41, 42, 45 rejected under 35 U.S.C. 103(a) as being unpatentable over Harper et al. (5,077,117).

Harper discloses the claims invention except for the substrate made of unsaturated polyester with e-glass fibers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to an unsaturated polyester with e-glass fibers, since it have been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. One of ordinary skill in the art would have been motivated to use an unsaturated polyester with e-glass fibers depending on the intended use of the marker.

12. Claims 6, 8, 24 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Schoyck (3,921,350) in view of Robbins, Jr. (4,340,633).

Van Schoyck discloses an anti-slip floor panel comprising an wood slat completely coated with an epoxy resin, where the resin comprises antiskid particles (col. 4, lines 33-42).

Van Schoyck fails to disclose a pattern of cuttable lines.

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Robbins discloses a protective mat comprising a protective shield such as a sheet of paper (substrate), an adhesive layer, and a plastic material, which has projecting cleats (cut-resistant anti-slip coating) (col. 2, lines 49-65 and figure 3). The cleats that project from the surface of the plastic material will grip the carpet and hold the mat in a desired position (col. 2, lines 34-39). The mat can be made of a variety of plastic materials such as Lucite or vinyl and are presently manufactured in a variety of shapes to accommodate different layouts (col. 2, lines 20-26). Robbins further discloses that for packaging the mats they can be attached and which is provided with severing lines on the plastic material in the form of perforations or score lines (uncoated cutting lines) to facilitate separation of the roll into individual segments (col. 3, lines 3-26).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add score lines to the mat of Van Schoyck as taught by Robbins. One of ordinary skill in the art would have been motivated to add the perforation lines to Van Schoyck's floor panel in order to store multiple panels together and allow the user to choose the size of the panel.

ANSWERS TO APPLICANT'S ARGUMENTS

13. Applicant's arguments filed in paper #8 regarding the 35 U.S.C. §112, §102 and §103 rejections of record have been considered but are moot due to the new grounds of rejections and since they have been withdrawn.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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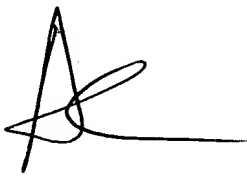
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac
5/18/03


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

5/19/03